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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/084,320

02/28/2002

Joe Cargnelli

9351-95

1996

1059

7590

04/20/2006

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CANADA

EXAMINER

FORD, JOHN K

ART UNIT

PAPER NUMBER

3753

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

58

Office Action Summary	Application No.		Applicant(s)	
	10/084,320		CARGNELLI ET AL.	
	Examiner		Art Unit	
	John K. Ford		3753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/1/06
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 5, 8, 11, 12, 18, 21-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-27 is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 8, 11, 12, 18, 21, 22, 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/1/06</u> | 6) <input type="checkbox"/> Other: _____ |

Applicant's reply of February 1, 2006 has been carefully considered. The specification has been amended to add new disclosure corresponding to the now amended claims 1 and 28. It is apparent that applicant continues to believe that it does not constitute the addition of "new matter" to essentially, in claim language, try to add the limitations that applicant tried to add previously by a proposed drawing correction to Figure 7 (denied entry in the previous office action).

PROPOSED CHANGE IN THE SPECIFICATION TO MIMIC LIMITATIONS
UNSUPPORTED BY ORIGINAL DISCLOSURE THAT HAVE BEEN ADDED TO
CLAIMS 1 AND 28 CONSTITUTE NEW MATTER

Starting with the drawing changes, the proposed drawing corrections to Figure 7 received September 12, 2005 and August 30, 2005 were not approved in the previous office action. In this response, applicant has withdrawn those proposed changes "without prejudice." Nonetheless, applicant persists in adding this same new matter into the disclosure, this time by amending the written portion of the disclosure. Most notably the heat exchanger immediately below heat exchanger 118a in originally filed Figure 7 (originally filed drawing is dated 02/28/02) has no fluid connections associated with it that support what is presently claimed in claims 1 and 28 (and which applicant is attempting to add to the written portion of the disclosure). The fact that the systems in the upper and lower portions of Figure 7 are disclosed as similar on page 9, lines 8-12 of the originally filed specification (note the term "many" and not "all" being used to

describe the correspondence of the elements between the upper and lower portions of Figure 7) does not permit applicant to engage in wholesale reconstruction of drawing Figure 7 or a re-writing of the specification to support what is newly claimed in the final paragraphs of each of claims 1 and 28. These new claim limitations added to claim 1 and 28 can only be derived from either of the proposed amended Figure 7 submission of August 30, 2005 or September 12, 2005, and both of those submissions were denied entry in the office action dated 11/29/2005 because of new matter.

The amendment filed February 1, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the portion that states that the second and fourth heat exchangers each have their own temperature control circuit having the claimed relationships (i.e. the last full paragraph of claims 1 and 28, as reproduced in the amendments made to the specification found on page 3, lines 16-22 and the last paragraph on page 5 of the February 1, 2006 response). As shown in original Figure 7, heat exchanger 118a is not connected to the un-legended heat exchanger below it at its right-hand side. Moreover the un-legended heat exchanger and the heat exchanger 164a do not have a common supply (in fact no supply connections are shown and only heat exchanger 164a has a return connection).

Applicant is required to cancel the new matter in the reply to this Office Action.

112 First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4, 5, 8, 11, 12, 18, 21-22 and 28-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant asserts that heat exchangers 118a and 126a are arranged to be provided with separate circuits, which circuits each have another heat exchanger (un-legended one below heat exchanger 118a and 164a) that are fed with a common coolant. This appears to be inaccurate because there are no coolant supply connections shown to the un-legended heat exchanger below heat exchanger 118a and the heat exchanger 164a. Likewise there is only a partial showing of a coolant return connection to heat exchanger 164a and no return connection to the un-legended heat exchanger below heat exchanger 118a.

Moreover on page 9, lines 8-12, it states that many of the elements of these two lines 90 and 92 are common. It clearly does not state that all the elements of the two lines 90 and 92 are common. It is very clear that much of the detail shown in the bottom half of Figure 7 is not identical to that shown in the top half, notwithstanding applicant's

remarks to the contrary. These differences, coupled with the fact applicant explicitly states that not all the elements between the upper and lower parts of Figure 7 are identical, coupled with the fact that there is no supply conduit shown at the bottom in Figure 7 render the currently claimed subject matter unsupported by the original disclosure. Indeed the valve (not legended) at the far left side of the lowest portion of Figure 7 appears to be controlled in a completely different way based on the lines connected to it at the valve actuator than a similar valve (148) at the top of Figure 7.

Therefore it cannot be stated with any reasonable assurance that applicant was in possession of the subject matter (namely the common coolant supply for the un-legended heat exchanger below heat exchanger 118a and the heat exchanger 164a) claimed here, at the time of invention. There are too many ambiguities in Figure 7 and the description thereof for one of ordinary skill to assume that unillustrated pipes (that applicant has attempted to add in the form of 144a and 146a in previously proposed drawing amendments, denied entry as containing new matter); if they even exist, were plumbed to a common source of coolant for the un-legended heat exchanger below heat exchanger 118a and the heat exchanger 164a.

Claims 23-27 are allowed.

Claims 1 and 28 would be allowable if the last paragraph in each of these claims is cancelled. Likewise to avoid the "new matter" objection to the specification, corresponding disclosure to the last paragraphs of each of claims 1 and 28 should be cancelled.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to John K. Ford at telephone number 571-272-4911.



John K. Ford
Primary Examiner